



Docket No.: P1139.0011/P011  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:  
Chad Roberts et al.

Application No.: 10/092,259

Confirmation No.: 9265

Filed: March 7, 2002

Art Unit: 2175

For: APPARATUS AND METHOD FOR  
CONFIGURING HANDHELD ELECTRONIC  
DEVICES

Examiner: B. M. Ortiz

**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is pursuant to 37 C.F.R. § 41.41 and is responsive to the Examiner's Answer mailed October 13, 2006 and Examiner's Supplemental Answer mailed November 16, 2006 in connection with the appeal from the final rejection of claims 1-19 mailed May 31, 2005 in the above-identified U.S. patent application. As required under § 41.41(a), this Reply Brief is filed within two months of the Examiner's Answer.

No fees are believed due for the filing of this Reply Brief. However, if any fee is due, the Patent Office is authorized to charge such fee to Deposit Account No. 04-1073.

As described in Appellants' Appeal Brief, each of the claims under final rejection is patentable over the reference cited by the Examiner. Appellants maintain each argument presented in the Brief.

In the Examiner's Answer, the Examiner presented several arguments in rebuttal of the positions taken in the Appeal Brief with regard to claims 1-18. Several of these rebuttal

points are inaccurate and will be addressed below. The Examiner does not appear to have addressed Appellants' arguments relating to claim 19.

First, the Examiner states that "the claim limitation 'build-to-order configuration engine for ...' is optional[] because [it] is an intended use and recited accordingly it does not hold any patentable weight." Appellants respectfully disagree that the "for" language creates optional claim limitations in this instance.

MPEP § 2106 sets forth the guidelines for patentable subject matter for computer-related inventions. While MPEP § 2106 II.C. states that "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation," statements of intended use are an example of language that may raise a question as to the limiting effect of the language in a claim. MPEP § 2106 II.C. However, the determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. MPEP § 2111.04; See also Hoffer v. Microsoft Corp. 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005) (The court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.").

Appellants submit that the claim limitation "build-to-order configuration engine for ..." is not optional in the context of the present invention. First of all, none of the previous Office Actions assert the grounds of rejection being presented here. See Office Actions dated September 20, 2004 and May 31, 2005. The Examiner has considered these limitations as material to patentability throughout prosecution of this application. For example, the Examiner points to several paragraphs of Mitchelmore which are alleged to disclose each of the functions of the configuration engine. See e.g., Office Action dated May 31, 2005 at page 2. It is only now, on appeal, that the Examiner has decided that the "for" clause has no patentable weight. Even in the Examiner's Answer, the Examiner continues to argue that particular paragraphs disclose each of the functions of the configuration engine. Examiner's Answer dated October 16, 2006 at page 9-10.

Additionally, the claim limitation of a "configuration engine" has no meaning without the context of what the configuration engine is supposed to do. The configuration of the

handheld device occurs when the “build-to-order configuration engine … communicat[es] with developers, coordinate[es] software licensing, arrang[es] software downloads and prevent[s] conflicts.”

Accordingly, the “for” clause of claim 1 cannot be ignored because it states a condition that is material to patentability, namely, the required functions that the “build-to-order configuration engine” must complete during configuration of the handheld device.

The Examiner alternatively points to several sections of the Mitchelmore reference which allegedly disclose the “build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.” Appellants respectfully disagree with the Examiner’s assertions. The Examiner appears to be picking and choosing discrete paragraphs of the Mitchelmore reference to disclose portions of the claim, merely based on the fact that these paragraphs of Mitchelmore have similar vocabulary. However, when read in context of the entire Mitchelmore application, Mitchelmore does not disclose the claimed invention.

Mitchelmore refers mainly to user interactions with the content developer. Mitchelmore requires the user to install specific software to interact with the system. The paragraphs cited by the Examiner selectively refer to how the system makes it easier for the content developer to provide his content to the system and to manage the content. Those paragraphs do not disclose, teach or suggest a “build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts,” as in the claimed invention.

The Examiner points to paragraph 17 of Mitchelmore as teaching a “build-to-order by a user and where the developer is the user.” Examiner’s Answer dated October 16, 2006 at page 8. The Examiner points to paragraph 18 of Mitchelmore as teaching the developers. Examiner’s Answer dated October 16, 2006 at page 9. Appellants are unclear as to how the combination of these two paragraphs allegedly discloses a build-to-order configuration engine as in the claims. Paragraph 17 merely discloses a “content delivery and management system.” Paragraph 18 of Mitchelmore relates to providing more effective and efficient content delivery by developers. These paragraphs refer, generally, to the originator of content’s ability to publish content to the

Internet. But they do not disclose, teach or suggest a configuration engine. In contrast, the claims of the present invention relate to allowing the end user of the PDA to configure their PDA at an abstracted level by providing a configuration engine that arranges everything for the user.

The Examiner points to paragraph 183 of Mitchelmore as teaching “software downloads, developers and preventing conflicts.” Examiner’s Answer dated October 16, 2006 at page 9. Paragraph 183 of Mitchelmore, however, relates to installation packages that are required to be able to use the Mitchelmore system. It does not refer to the system downloading a set of software onto a handheld device. The configuration engine of claim 1 coordinates software downloads by doing a complete load of desired software onto the device while also checking for conflicts and memory allocation. Specification, paragraphs [00018] and [00019]. Additionally, paragraph 183 does not discuss preventing conflicts.

The Examiner points to paragraph 8 of Mitchelmore as teaching software licensing. Examiner’s Answer dated October 16, 2006 at page 9. However, the “licensed development platform” of paragraph 8 does not disclose the “coordinating software licensing” portion of claim 1. Instead, a “licensed development platform” is generally known in the art as a set of tools provided by a computer system owner in order to allow programmers to create programs which will be compatible with their system, thereby encouraging more people to buy and use their system. These platforms are “licensed” to users. Appellants submit that the fact that Mitchelmore discusses software licensing generally (e.g., the fact that it occurs in the context of licensed development platforms) does not disclose a configuration engine for coordinating software licensing.

The Examiner points to paragraph 58 of Mitchelmore as teaching preventing conflicts. Examiner’s Answer dated October 16, 2006 at page 10. Appellants are unclear as to how this paragraph relates to preventing conflicts among software downloads. Paragraph 58 discusses outsourced solutions for software, data management, support, etc. The build-to-order configuration engine, on the other hand, prevents conflicts among software programs installed on the handheld device and makes sure the software is compatible with the device.

Also, the Examiner gives a definition of "license" as "to give permission, to permit, authorize or consent to" and points to paragraph 102 to state that Mitchelmore thus teaches licensing, as recited in claim 1. Examiner's Answer dated October 16, 2006 at page 10. While the user in Mitchelmore does receive a license to use the system (as disclosed in paragraph 102), Mitchelmore does not provide a configuration engine which coordinates several software licenses of third party software, as provided for in claim 1. See also Specification, paragraphs [0022] and [0026]. The license discussed in paragraph 102 of Mitchelmore is merely a single license to which the user agrees in order to use the Mitchelmore system.

The other specific arguments relating to the patentability of the claims set forth in the Appeal Brief are maintained.

Accordingly, Appellants respectfully submit that the reference of record does not anticipate the claimed invention. Reversal of the final rejection of claims 1-19 is respectfully requested.

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Dated: December 12, 2006

Respectfully submitted,

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